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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,001	05/24/2000	C. Daniel McClain	ROWL-9955	4546
23123	7590	07/12/2005	EXAMINER	
SCHMEISER OLSEN & WATTS 18 E UNIVERSITY DRIVE SUITE # 101 MESA, AZ 85201			SANDERS, KRIELLION ANTIONETTE	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/578,001

Applicant(s)

MCCLAIN ET AL.

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 87-327 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 87-327 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/19/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 87-327 of this application have been copied by the applicant from U.S. patent No. 6,531,537 or drafted as proposed counts to an Interference proceeding. These claims are not patentable to the applicant because they have been found to be unpatentable under 35 USC 112 and/or 35 USC 103. An Interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

### ***Objection to specification***

The amendment filed 4/18/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: All new amendments to pages 2, 6, 9 and 10.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1.

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Claims 87, 88, 90, 91, 93, 94, 96, 97, 99, 100, 102, 103, 105, 111, 112, 114, 115, 117, 118, 120, 121-124, 126, 127, 129, 130, 132, 133, 135, 136, 138, 139, 141, 142, 144, 145, 147, 148, 150, 151, 153, 154, 156, 157, 159, 160, 162, 163, 165, 166, 168, 169, 171, 172, 174, 175, 177, 178, 180, 181, 183, 184, 186, 187, 189, 190, 192, 193, 195, 196, 198, 199, 201, 202, 204, 205, 207-230, 247, 248-258, 310, 311, 321, 324 and 325 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe the following claimed components of the presently claimed invention:

**The specification does not indicate what is intended by the term, "mutually compatible".** Applicant uses the term, mutually compatible to describe the prepaunts of the claimed invention, yet, this term is not defined by the specification. The ordinary practitioner in this art would not know what applicant intends by this term. US Patent 6,531,537 to Friel et al. defines the term, "mutually compatible" as being relevant in describing prepaunts that if when admixed, show no signs of colloidal instability such as flocculation. See col. 4, lines 7-25 of Friel et al. Even if applicant were attempting to use the phrase "mutually compatible" in the same manner as Friel et al, there is nothing in the specification which would suggest that applicant's prepaunts are free of signs of colloidal instability and flocculation.

Claims 87, 88, 90, 91, 93, 94, 96, 97, 99, 100, 102, 103, 111, 112,,l 114, 115, 117, 118, 120, 121, 123, 124, 126, 127, 129, 130, 132, 133, 135, 136, 138, 139, 141, 142, 144, 145, 147, 148, 150, 151, 153, 154, 16, 157, 159, 160, 162, 163, 165, 166, 168, 169, 171, 172, 174, 175, 177, 178, 180, 181, 183, 184, 186, 187, 189, 190, 192, 193, 195, 196, 198, 199, 201, 202, 204 and 205 are

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rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**The specification does not indicate what is intended by the term, "extender pigment", nor is there any evidence that applicant utilizes an "extender pigment" in the present invention.** The specification fails to describe the following claimed components of the presently claimed invention:

The specification does not indicate what is intended by the term, "extender pigment". Applicant uses the term, "extender pigment" to describe the preprints of the claimed invention, yet, this term is not defined by the specification. The ordinary practitioner in this art would not know what applicant intends by this term. US Patent 6,531,537 to Friel et al. provides a list of suitable, "extender pigments". See col. 10, line 53 through col. 11, line 2 of Friel et al. Even if applicant were attempting to use the phrase "extender pigments" to mean the same as in the Friel et al, there is nothing in applicant's specification which would suggest that applicant actually includes such components as calcium carbonate or aluminum silicate in the presently claimed preprints.

Claims 87, 90, 93, 96, 99, 105, 111, 117, 120, 123, 126, 129, 132, 135, 138, 141, 144, 147, 150, 153, 156, 159, 162, 165, 168, 171, 174, 177, 180, 183, 186, 189, 192, 195, 198, 201, 204 and 247 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**The specification does not indicate what is intended by the term, "latex polymeric binder", nor is there any evidence that applicant utilizes a "latex polymeric binder" in the present invention.** The specification fails to describe the following claimed components of the presently claimed invention:

The specification does not indicate what is intended by the term, "latex polymeric binder".

Applicant uses the term, "latex polymeric binder" to describe the preprints of the claimed invention, yet, this term is not included in the specification. The ordinary practitioner in this art would not know which polymeric components applicant intends by this term. US Patent 6,531,537 to Friel et al. provides a list of suitable, "latex polymeric binders for his invention".

See col. 11, lines 3 through 28 of Friel et al. Even if applicant were attempting to use the phrase "latex polymeric binder" to mean the same as in the Friel et al invention. There is nothing in applicant's specification that would suggest that applicant actually includes latex polymeric binders such as polyvinyl acetate or styrene butadiene in the presently claimed preprints.

Applicant indicates at page 9, lines 5-13 of his specification that the resin utilized in the presently claimed paint products is a 100 % acrylic acrynol resin. This resin does not appear to correspond to the latex [polymeric binders defined in the Friel et al patent.

Claims 87-258 and 261-312 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**The specification does not describe what is intended by the term, "opacifying pigment".** The specification fails to describe the following claimed components of the presently claimed invention:

The specification does not indicate what is intended by the term, "opacifying pigment". Applicant uses the term, "opacifying pigment" to describe the preprints of the claimed invention, yet, this term is not included in the specification. The ordinary practitioner in this art would not know which types of pigments applicant intends by this term. US Patent 6,531,537 to Friel et al. describes opacifying pigments as white pigments which impart white scattering power to the paint across visible wavelengths without a high degree of absorption. Patentee indicates that opacifying pigments may be titanium dioxide, or a combination of titanium dioxide and auxiliary hiding pigments such as voided latex polymer particles, zinc oxide, lead oxide, synthetic polymer pigment and mixtures. See col. 10, lines 7 through 52 of Friel et al. Even if applicant were attempting to use the phrase "opacifying pigment" to have the same meaning as in the Friel et al invention, there is nothing in applicant's specification that would suggest that applicant actually includes these types of opacifying pigments in the presently claimed preprints. Applicant indicates at the paragraph bridging pages 6 and 7 of his specification that his invention includes a pigment-containing constituent containing titanium dioxide. This pigment does not appear to correspond to opacifying pigment in the manner described by Friel and applicant provides no other description of the component.

Claims 93, 94, 95, 96, 97, 98, 135-140, 183-188, 235-236, 263-264, 277-278, 293-294 and 315-316 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**The specification does not describe a component wherein a premixed pigment composition further comprises at least one resinous binder adsorbed onto the opacifying pigment, extender pigment or flattening agent.**

### **Response to Amendments to specification**

**Applicant's amendments to the specification do not overcome the rejections under 35 USC 112 1<sup>st</sup> Paragraph because the present claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, that applicant had possession of the claimed invention.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 99-101, 147-149, 195-197, 225, 226, 227, 228, 231-260, 265, 281, 297, 310, 311 and 313 through 326 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for



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failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "PVC" in claims 99-101, 147-149, 195-197, 225, 226, 227, 228, 231-260, 265, 281, 297, 310, 311 and 313 through 326 is used by the claim to mean "an undetermined functional value that is not clear from the present disclosure", while the accepted meaning is "polyvinyl chloride." The term is indefinite because the specification does not clearly redefine the term.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 207-212, 232-234, 237, 243, 244, 301-303, 306, 313, 314, 316, 319, 320 and 327 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, US Patent No. 5,643,669.

Applicant's invention relates to a preprint or composition comprising a combination of an opacifying pigment, a latex polymeric binder and a flattening agent. Tsuei discloses water based

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coating compositions which may be used to formulate paints. The compositions which possess a solids content of 30-70% per weight of composition comprise an acrylic based resin (urethane/acrylic), and may possess a thickener, a flattening agent and colorants such as titanium dioxide. See col. 3, lines 14-31, col. 4, lines 2-21, col. 6, lines 16-32, col. 7, lines 15-47, col. 9, lines 44-65 and col. 16, lines 39-64. Titanium dioxide is an opacifying pigment. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to select the a thickener, a flattening agent and titanium dioxide colorant set forth in Tsuei to formulate a paint e col. 6, lines 31-44. Patentee relates the viscosity in centipoises and does not address KU, however it would be obvious to the skilled artisan to adjust the viscosity of the paint compositions of Tsuei by altering the quantity of the thickening agent until the desired viscosity is achieved.

#### ***Response to arguments***

Applicant's arguments filed 4/18/05 have not been found to be persuasive because applicant avers that Tsuei teaches to form paints as opposed to prepaints. Applicant also states that Tsuei "does not teach to add the other essential paint elements as a separate prepaint, but teaches to mix them all together". Applicant also states that, "Each of the prepaints by themselves, are not intended to be paint by themselves but only after combination with other prepaint compositions." Applicant indicates that prepaints become paints only after combination with other prepaint compositions. Applicant states that Tsuei teaches to mix all essential paint elements together. Applicant has not distinguished between a pre-paint and the compositions of Tsuei. In either instance, all essential elements are mixed together to form a paint.

***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kriellion A. Sanders  
Primary Examiner  
Art Unit 1714

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